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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,383	07/18/2003	Faramarz Vaziri	JEL 30416D	4039

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EXAMINER

PATEL, AJIT

ART UNIT	PAPER NUMBER
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2664

DATE MAILED: 01/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,383

Applicant(s)

VAZIRI ET AL.

Examiner

AJIT G. PATEL

Art Unit

2664

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 53-84 is/are pending in the application.
- 4a) Of the above claim(s) 85-92 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 53-59, 61-66, 68-74, 76-81, 83 and 84 is/are rejected.
- 7) ☒ Claim(s) 60, 67, 75 and 82 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1 page.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 53-84 are drawn to establishing a telephone call over IP, classified in class 370, subclass 352.
 - II. Claims 85-92 are drawn to voice mail messaging system, classified in class 379, subclass 67.1.

The inventions are distinct, each from the other because of the following reasons:

The above inventions are separate, distinct, and independent. Neither requires other for its implementation, they have separate statuses in the art as shown by their different classification. Each invention, if allowable, would be capable for supporting a separate patent. Therefore, restriction for examination purposes is proper.

2. This application contains claims 85-93 are drawn to an invention nonelected with traverse in last response. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 53,55-58,83,84 are rejected under 35 U.S.C. 102(e) as being anticipated by White et al (US Pat. # 6,711,241).

Regarding claim 53, White et al disclose Internet telephone service which incorporating the steps of associating a telephone number provided by a first terminal with a first Internet Protocol address (83 of fig. 3; 104, 112 of fig. 4); establishing an Internet communication link in a communication path between the first terminal and a second terminal using the associated first IP address (col. 7, line 30- line 9, col. 7; fig. 4); and communicating information across the established Internet communication link (col. 7, line 30- line 9, col. 7; fig. 4).

Regarding claim 55, White et al disclose the step of converting the communicated into an analog form; and reproducing the analog form of the information audibly (lines 18-46, col. 7).

Regarding claim 56, White et al disclose the step of communicating the information across a first public switched telephone network (PSTN) link before communicating the information across the Internet communication link (102 of fig. 4).

Regarding claim 57, White et al disclose the step of communicating the information across a public switched telephone network link after communicating the information across the Internet communication link (114 of fig. 4).

Regarding claim 58, White et al disclose the step of communicating the information across a second PSTN link after communicating the information across the Internet communication link (114 of fig. 4).

Regarding claim 83, White et al disclose a first telephone set (100 of fig. 4) operable to be connected to a second telephone set (118 of fig. 4) over a primary network (102 114 of fig. 4) and a secondary network (106 of fig. 4), the first telephone set comprising a connecting circuit operable to enable connection of the first telephone set to the primary network and the secondary network; and a server (104,112 of fig. 4), that locates the second telephone set with respect to the secondary network and that establishes a connection over the secondary network and the primary network between the first telephone set and the second telephone set (figs.3 and 4).

Regarding claim 84, White et al disclose that the primary network is the PSTN (102,114 of fig. 4) and the secondary network is the Internet (106 of fig. 4).

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 54,59,60,61 are rejected under 35 U.S.C. 103(a) as being unpatentable over White et al in view of Ng et al (US pat. 6,243,376).

Regarding claim 54, White et al disclose all the subject matter as described in previous paragraph except disclose the step of associating a telephone number provided by the second terminal with a second IP address,

wherein the Internet communication link is established using the first and second IP addresses. Ng et al disclose a method and apparatus for making a phone call connection over the Internet connection disclose the step of disclose the step of associating a telephone number provided by the second terminal with a second IP address, wherein the Internet communication link is established using the first and second IP addresses (col. 1, line 63 through line 8, col. 2). Therefore, it would have been obvious to one skilled in the art to use the step of disclose the step of associating a telephone number provided by the second terminal with a second IP address, wherein the Internet communication link is established using the first and second IP addresses as taught by Ng et al in the system of White et al in order to set up a phone call connection over an Internet connection automatically.

Regarding claim 59, White et al fail to disclose the step of communicating the telephone numbers provided by the first and second terminals to an IP server, wherein the IP server associates the respective telephone numbers with the first and second IP addresses and enables the establishment of the Internet communication link based on the first and second IP addresses. Ng et al disclose a method and apparatus for making a phone call connection over the Internet connection disclose the step of communicating the telephone numbers provided by the first and second terminals to an IP server, wherein the IP server associates the respective telephone numbers with the first and second IP addresses and enables the establishment of the Internet communication link

based on the first and second IP addresses (col. 1, line 63 through line 8, col. 2). Therefore, it would have been obvious to one skilled in the art to use the step of communicating the telephone numbers provided by the first and second terminals to an IP server, wherein the IP server associates the respective telephone numbers with the first and second IP addresses and enables the establishment of the Internet communication link based on the first and second IP addresses as taught by Ng et al in the system of Whit et al in order to set up a phone call connection over an Internet connection automatically.

Regarding claim 61, White et al fail to disclose the step of correlating the telephone number provided by the first terminal with a telephone number provided by the second terminal to provide the association between the telephone number provided by the first terminal and the first IP address. Ng et al disclose a method and apparatus for making a phone call connection over the Internet connection disclose the step of correlating the telephone number provided by the first terminal with a telephone number provided by the second terminal to provide the association between the telephone number provided by the first terminal and the first IP address (lines 9-27, col. 2). Therefore, it would have been obvious to one skilled in the art to use the step of correlating the telephone number provided by the first terminal with a telephone number provided by the second terminal to provide the association between the telephone number provided by the first terminal and the first IP address as taught

by Ng et al in the system of White et al in order to set up a phone call connection over an Internet connection automatically.

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 62,63,68-70,74,77,78 are rejected under 35 U.S.C. 102(e) as being anticipated by Ng et al.

Regarding claim 62,68,69,74,77 Ng et al disclose a method and apparatus for making a phone call connection over the Internet connection disclose the step of correlating a first destination telephone number provided by a first terminal with a first origination telephone number provided by a second terminal to associate a first Internet protocol (IP) address with the first destination telephone number (col. 1, line 56 through line 27, col. 2); correlating a second destination telephone number provided by the second terminal with a second originating telephone number provided by the first terminal to associate a second IP address with the second destination telephone number (col. 1, line 56 through line 27, col. 2); establishing an Internet communication link in a communication path between the first and second terminals using the

associated first and second IP addresses (305 of fig. 4) and communicating information across the established Internet communication link (309 of fig. 4).

Regarding claim 63,70,78 Ng et al disclose the step of converting the information into an analog form and reproducing the analog form of the information audibly (lines 56-52, col. 4).

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 64-66,71-73,79-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng et al in view of White et al.

Ng et al fail to disclose the limitations recited in claims 64-66,71-73,79-81. White et al disclose the limitations previously described in claims 56-58. Therefore, it would have been obvious to one skilled in the art to use the limitations taught by White et al in the system of Ng et al in order to set up the internet connection from PSTN to IP network.

11. Claims 60,67,75,82 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to AJIT G. PATEL whose telephone number is 571-272-3140. The examiner can normally be reached on MONDAY-THURSDAY.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wellington Chin can be reached on 571-272-3134. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AP


Ajit Patel
Primary Examiner